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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/640,748 | 08/18/00 | MOHR | J SCH 1664 C1 |

023599 HM12/0913
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| EXAMINER | |
|----------|--------------|
| TRINH, B | |
| ART UNIT | PAPER NUMBER |

1625
DATE MAILED: 09/13/01
9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|-----------------|------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/640,748 | MUHR et al |
| Examiner | TRINH | Group Art Unit 1625 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 6 - 6 - 01

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 4 - 6, 8 - 9 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 4 - 6, 8 - 9 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) 09/242,334.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

| | |
|--|---|
| <input type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ | <input type="checkbox"/> Interview Summary, PTO-413 |
| <input type="checkbox"/> Notice of Reference(s) Cited, PTO-892 | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948 | <input type="checkbox"/> Other _____ |

Office Action Summary

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Claims 4-6, 8-9 are pending.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The compound which contains X being an anion had not been disclosed and/or taught in the specification. The specification does not contain the definition of the term X as well.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze et al.

Schulze et al teaches a purified carbolactone which has a chemical formula identical to the instant carbolactone; note the Abstract, the second compound in column 3, compound in lines 5-11 in column 8 and compound of claim 6 of the patent. The patented compound is made by a process different from the current process and does not contain the specific impurities as

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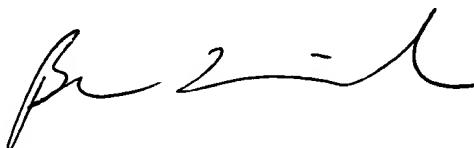
mentioned by the current compound. However, since both the claimed compound and the patented compound have identical chemical structures, the claimed invention would be deemed obvious over the patented compound in the absence of unobvious and/or unexpected results because a compound can be made by more than one process.

No claim is allowed.

Any inquiry concerning this communication should be directed to Ba Trinh at telephone number (703) 308-4545.

Trinh:mv

August 29, 2001



BA K. TRINH
PRIMARY EXAMINER
GROUP 1200, 1625